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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/668,091	09/19/2003	Frederick James Diggle III	BE1-0002US	1284
49584	7590	09/12/2005	EXAMINER	
LEE & HAYES, PLLC 421 W. RIVERSIDE AVE. SUITE 500 SPOKANE, WA 99201			MEISLIN, DEBRA S	
			ART UNIT	PAPER NUMBER
			3723	

DATE MAILED: 09/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

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<b>Office Action Summary</b>	<b>Application No.</b> 10/668,091	<b>Applicant(s)</b> DIGGLE ET AL.	
	<b>Examiner</b> Debra S. Meislin	<b>Art Unit</b> 3723	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 18 July 2005.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-3 and 7-13 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Her (5,086,674) in view of Cornia.

Her discloses a socket body "40", arm "20", hex key tip "51", and an opening "25" to receive a torque arm "80". Her discloses all of the claimed subject matter except for the device being of one piece, unitary construction and except for having a notch in the key tip. Cornia discloses a socket hand tool being of one piece, unitary construction. It would have been obvious to one having ordinary skill in the art to form the device of Her as one piece as taught by Cornia since the use of a one piece construction would be merely a matter of obvious engineering choice.

*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

Cornia discloses a notch in a key tip "40". It would have been obvious to one having ordinary skill in the art to form the device of Her with a notch in the key tip to enable the device to be driven by a screwdriver as taught by Cornia.

3. Claims 1-2 and 7-12 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Her (5,086,674) in view of Marleau.

Her discloses a socket body "40", arm "20", hex key tip "51", and an opening "25" to receive a torque arm "80". Her discloses all of the claimed subject matter except for the device being of one piece, unitary construction. Marleau discloses a socket hand tool being of one piece, unitary construction. It would have been obvious to one having ordinary skill in the art to form the device of Her as one piece as taught by Marleau since the use of a one piece construction would be merely a matter of obvious engineering choice.

*In re Larson*, 340 F.2d 965, 968, 144 USPQ 347, 349 (CCPA 1965) (A claim to a fluid transporting vehicle was rejected as obvious over a prior art reference which differed from the prior art in claiming a brake drum integral with a clamping means, whereas the brake disc and clamp of the prior art comprise several parts rigidly secured together as a single unit. The court affirmed the rejection holding, among other reasons, "that the use of a one piece construction instead of the structure disclosed in [the prior art] would be merely a matter of obvious engineering choice.")

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Her in view of Cornia or Marleau as applied above, in further view of Ittel.

Ittel discloses an opening extending partially through an arm for receiving a torque member. It would have been obvious to one having ordinary skill in the art to form the opening of Her as extending partially through the arm to receive a torque member as taught by Ittel.

5. Claims 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Her in view of Cornia or Marleau as applied above, in further view of Hedden.

Hedden discloses a socket wrench tool being formed of metal. See column 3, line 7 of Hedden. It would have been obvious to one having ordinary skill in the art to form the device of Her out of metal for its known strength properties as taught by Hedden.

6. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Her in view of Cornia or Marleau as applied above, in further view of Arnold.

Arnold discloses a plastic sheath/sleeve around the socket. It would have been obvious to one having ordinary skill in the art to form the device of Her with a plastic sheath/sleeve around the socket to allow for added grippability and to facilitate size recognition as taught by Arnold.

7. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Her in view of Cornia as applied above, in further view of Ittel.

Ittel discloses an opening extending partially through an arm for receiving a torque member. It would have been obvious to one having ordinary skill in the art to form the opening of Her as extending partially through the arm to receive a torque member as taught by Ittel.

8. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Her in view of Cornia and Ittel as applied above, in further view of Arnold.

Arnold discloses a plastic sheath/sleeve around the socket. It would have been obvious to one having ordinary skill in the art to form the device of her with a plastic sheath/sleeve around the socket to allow for added grippability and to facilitate size recognition as taught by Arnold.

9. Claims 16-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gonzales, Jr. in view of Her.

Gonzales, Jr. discloses first and second interconnected socket bodies "12", sockets "13", arms "16", and key tips "14". See figures 1 and 4. Her discloses a socket

body "40", arm "20", key tip "51", and an opening "25" in the arm to receive a torque arm "80" (see figures 3 and 4). It would have been obvious to one having ordinary skill in the art to form an arm portion of Gonzales, Jr. with an opening to enable the receipt of a torque arm to provide the socket with torque as inherently taught by Her.

10. Claims 16-19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Marleau or in view of Her.

Marleau discloses all of the claimed subject matter except for having a torque opening in the arm. Marleau discloses a torque opening in the socket body. Her discloses a socket body "40", arm "20", key tip "51", and an opening "25" in the arm to receive a torque arm "80" (see figures 3 and 4). It would have been obvious to one having ordinary skill in the art to form the opening of Marleau in the arm, as opposed to in the socket body, as such would have been an obvious relocation of parts as taught by Her.

11. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Marleau or in view of Her, as applied above, in further view of Ittel.

Note that Her discloses a key tip in the form of a hex. It would have been obvious to one having ordinary skill in the art to form the differently sized key tips of Marleau in the form of a hex to enable the engagement of inner hex screws as taught by Her. Ittel discloses an opening extending partially through an arm for receiving a torque member. It would have been obvious to one having ordinary skill in the art to form the opening of Marleau as extending partially through the arm to receive a torque member as taught by Ittel.

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12. Applicant's arguments filed July 18, 2005 have been fully considered but they are not persuasive and are deemed moot in view of the new ground(s) of rejection.

Cornia and Marleau were applied to the rejection of the claims to teach the concept of forming the tool as a one piece, unitary construction.

Her discloses a slot "25" capable of being engaged by a torque arm, as claimed by applicant. Additionally, note figures 3 and 4 of Her wherein rotation of the torque arm "80" about the longitudinal axis of the arm portion "20" allows for the application of torque to the key tip "50, 51" located in the end socket "33". Figure 3 clearly shows the torque arm being located to provide a longer torque arm for added torque and figure 4 shows the torque arm being located to provide a shorter torque arm that may be engaged by both hands on opposite ends thereof. See, also, column 1, lines 39-42 of Her.

Additionally, a recitation of the intended use ("to receive a torque arm device") of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Her discloses a slot "25" capable of being engaged by a torque arm.

In response to applicant's argument that the examiner has combined an excessive number of references, reliance on a large number of references in a rejection does not, without more, weigh against the obviousness of the claimed invention. See *In re Gorman*, 933 F.2d 982, 18 USPQ2d 1885 (Fed. Cir. 1991).

In response to applicant's request for the examiner to provide more description as to how the teachings of Her and Gonzales, Jr. may be combined, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). In figure 4, Gonzales, Jr. discloses a second tool "12" (far left of fig. 4) and a first tool "10" into which the second tool "12" extends. Gonzales, Jr. discloses first and second interconnected socket bodies "12", sockets "13", arms "16", and key tips "14". See figures 1 and 4. Her discloses a socket body "40", arm "20", key tip "51", and an opening "25" in the arm to receive a torque arm "80" (see figures 3 and 4). It would have been obvious to one having ordinary skill in the art to form an arm portion of Gonzales, Jr. with an opening to enable the receipt of a torque arm to provide the socket with torque as inherently taught by Her. Forming an opening in the first tool "10" arm portion would allow for access to the opening.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re*



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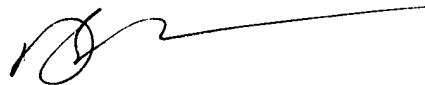
*Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Her teaches forming a recess in an arm portion of a tool.

Marleau discloses a first tool (fig. 1a), a second tool (fig. 1b) nested within the first tool, a key tip "12", an arm "10", a socket body (unnumbered, to the right of arm "10"), an opening "18" for receipt of a torque arm. Note that even when nested, the opening "18" is accessible to receive a torque arm device at least partially into the opening.

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Debra S. Meislin whose telephone number is 571 272-4487. The examiner can normally be reached on M-F, alt. Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Hail can be reached on 571 272 4485. The fax phone number for the organization where this application or proceeding is assigned is 571 273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Debra S Meislin  
Primary Examiner  
Art Unit 3723

September 7, 2005